

Appl. No. 10/522,116

Amd. Dated February 23, 2007

Reply to Office Action Dated June 25, 2007

REMARKS

The title has been objected to as being not descriptive. The title has been amended to include the phrase "Electrically operated" and thus describe the invention. Reconsideration and withdrawal of the objection is respectfully requested.

Claims 14, 15, 19, 23, 26, and 28 stand rejected as including parenthetical phrases and thus being informal. These phrases have been deleted.

Claim 5 has been objected to because of informalities, the appropriate corrections have been made.

Claim 23 has been objected to as having informalities due to an unclear phrase, this phrase has been deleted.

Claim 35 has been objected to under 35 U.S.C. 112 as being indefinite, this claim has been cancelled.

Claim rejections – US 35 USC 102

Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Coenen et al US 6,305,469.

Coenen et al. discloses an actively an electrically operated drilling system and method for drilling wells.

The Examiner asserts that Coenen et al. discloses "first stream of produced fluid flows directly to the surface through the hydrocarbon production conduit and a second stream of produced fluid is pumped over the cutting surfaces of the drilling device via a remotely operated downhole pumping means(14)" (Office Action of June 25, 2007, page 3, lines 3-5). However, Coenen provides these flows of fluid one after the other through a second wellbore section and not, as is currently claimed a second stream of produced fluid. In the present invention this is a second parallel stream in Coenen it is s second

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section of wellbore. Coenen et al. specifically refers to "the drilling fluid present in the wellbore 1 is thereby gradually replaced by hydrocarbon fluid." in " (Coenen et al., col. 5, line 21.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Because Coenen et al. does not disclose "a second stream of produced fluid" as set out in claim 1, the anticipation rejection is not proper. Reconsideration and withdrawal of the rejection is requested.

Claims 2 – 11 are dependent upon claim 1 and therefore similar arguments apply and reconsideration and withdrawal of the objection is requested.

Claim 35 is rejected under 35 U.S.C. 102(b) as being anticipated by Quigley et al. Claim 35 is herein cancelled rendering this objection moot.

Claims 26-29 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Coonan et al... in view of Quigley et al. (US 5,921,285). Coenen et al., does not teach or suggest "a second stream of produced fluid" as set out in independent claim 1. Claims 26 – 29 are each dependent on Claim 1. Nothing in Coenen suggests modifying the device to include such a second stream. Since the asserted combination does not teach or suggest each and every limitation of the claims, the claims are asserted to be patentable. Reconsideration and withdrawal of the rejection is requested.

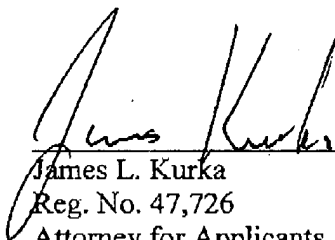
Claims 30 and 31 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Coenen et al.. in view of Bailey et al. (US 6,454,007). Coenen et al., does not teach or suggest "a second stream of produced fluid" as set out in independent claim 1. Claims 30 and 31 are each dependent on Claim 1. Nothing in Coenen suggests modifying the device to include such a second stream. Since the asserted combination does not teach or

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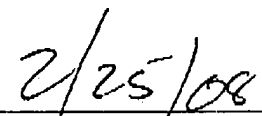
suggest each and every limitation of the claims, the claims are asserted to be patentable.
Reconsideration and withdrawal of the rejection is requested.

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If an issue has not been addressed, the Examiner is encouraged to contact the undersigned. In the event there are additional charges in connection with the filing of this Response, the Commissioner is hereby authorized to charge the Deposit Account No. 50-2183 (reference 21.1268) in the amount of any necessary fee.

Respectfully submitted,


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